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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,049	03/15/2001	Kris Nyhus	53130/29880	7290

7590

04/02/2004

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EXAMINER

MEHTA, ASHWIN D

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 04/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/811,049

Applicant(s)

NYHUS, KRIS

Examiner

Ashwin Mehta

Art Unit

1638

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: 1-5 and 20.

Claim(s) objected to: 13,14,16 and 17.

Claim(s) rejected: 6-12,15,18 and 19.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: the amendment to the specification was entered.


ASHWIN D. MEHTA, PH.D
PATENT EXAMINER

Continuation of 2. NOTE: Claims 18, 21, and 32 contain new matter- the specification does not have written descriptive support for the claimed method, involving the recited number of crosses. The specification also does not recite "5% significance level." The claims would also be rejected under 35 U.S.C. 112, 1st paragraph for not describing all altered starch traits. Claim 21 also introduces an indefinite issue in that it is not clear if "the seed produced thereon" refers to the seed resulting from a cross involving the claimed plant, or the seed that produces the claimed plant. Claim 21 would be rejected for lack of written description if the seed represents the next generation. Claim 12 would be objected to for broadening the scope of the claim from which it depends. The plant of claim 12 would have traits not possessed by the of its parent claim, and so does not encompass the limitations of its parent claim. Claims 23 and 27 are indefinite for improper antecedent basis- the claims indicate that claim 12 is a method claim, whereas claim 12 is directed to a product. Claim 24 also recites new matter- not all of the recited transgenes have written descriptive support in the specification. Claim 28 fails to limit its parent claim- it has the same genotype and phenotype, as it is the result of selfing an inbred. Claim 29 recites new matter- the specification does not support the claimed seed. Claim 31 is indefinite because the specification (page 25, line 6) refers to the recited members of the Markush group as genes, not traits.

Continuation of 3. Applicant's reply has overcome the following rejection(s): the objection to claims 13, 14, 16, and 17; the rejection of claim 15 under 35 U.S.C. 112, 2nd paragraph; the rejection of claims 6-11, 15, 18, and 19 under 35 U.S.C. 112, 1st paragraph; the rejection of claim 15 for reciting new matter; the rejection of claims 12 and 15 under 35 U.S.C. 112, 1st paragraph. Note however that the claim amendments were not entered, for the noted reasons.

Continuation of 5. does NOT place the application in condition for allowance because: for the reasons indicated above. The amendment does not overcome the rejection of claim 12 under 35 U.S.C. 112, 2nd paragraph, because the claim 3 indicates that any plant that regenerates from the claimed tissue culture expresses the characteristics of G4901. However, the plant of claim 12 will not, since it has traits not possessed by the plant of claim 3, and because of the transgene will alter traits expressed by the plant of claim 3. Claim 21 would be rejected under 35 U.S.C. 112, 1st paragraph, for the reasons of record cited in the last Office action for claims 6-11, 15, 18, and 19, if the seed represents the product of crossing the plant with another plant. .